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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Timothy P. Michel
Serial No.: 10/696,643
Conf. No.: 7780
Filed: 10/29/2003
For: SCROLL COLLAR FOR RECIPROCATING SAW

Art Unit: 3724
Examiner: Peterson, Kenneth E.

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1/20/07
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Appr. February 20, 1998 Attorney for Applicants

MS Appeal Brief-Patents
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Sir:

Transmitted herewith is the Appeal Brief in this application in response to the Notification of Non-Compliant Appeal Brief dated December 15, 2006.

The fee in the amount of \$500.00 was paid on October 19, 2006.

The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any overpayment to Deposit Account No. 07-2069. Should no proper payment be enclosed, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. (One additional copy of this Notice is enclosed herewith.)

Respectfully submitted,

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January 8, 2007

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APPELLANT'S BRIEF ON APPEAL PURSUANT TO 37 CFR § 41.37

This Appeal Brief is in support of Applicant's Notice of Appeal dated August 22, 2006.

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REAL PARTY IN INTEREST

Credo Technology Corporation.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims that are pending, rejected and appealed are 1-3, 5, 6, 19 and 20.

Claims 4, 7-12, 15, 17, 18, 21 and 22 stand withdrawn. Claims 13, 14 and 16 are cancelled without prejudice.

STATUS OF AMENDMENTS AFTER FINAL

No amendments have been made that have not been considered by the examiner.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention generally concerns power hand tools. More particularly, the independent claims, which are claims 1 and 19 are annotated with references to the specification and drawings, as follows:

1. A scroll collar (44; Figs. 1, 2; Pg 5/13-7/14) and a reciprocating tool assembly (10; Figs 1, 2; Pg 3/7-12) for providing a rotating grip, comprising:

a reciprocating tool (10; Figs 1, 2; Pg 3/7-12) having a housing (14; Figs. 1, 2; Pg 3/7-12, 4/5-17) and a working end (12; Figs. 1, 2; Pg 4/5-12) to which a reciprocating tool blade (20; Figs 1, 2; Pg 4/5-12) can be attached;

a support structure (66; Figs. 3, 4; Pg 3/7-12, 7/1-15) on said housing adjacent said working end; and

a generally cylindrical scroll collar (44; Figs. 1-4; Pg 3/1-16, 5/13-7/14) carried by said support structure and configured to rotate relative to said support structure and an attached reciprocating tool blade around a scroll collar axis (52; Fig. 3; Pg 5/15-6/10).

19. A reciprocating tool (10; Figs 1, 2; Pg 3/7-12) for use with a scroll collar assembly having a support structure (66; Figs. 3, 4; Pg 3/7-12, 7/1-15) and a scroll collar, comprising:

a motor housing (16; Figs. 1, 2; Pg 3/7-12, 4/5-17);

a gear housing (14; Figs. 1, 2; Pg 3/7-12, 4/5-17) disposed adjacent to said motor housing and a working end (12; Figs. 1, 2; Pg 4/5-12) disposed adjacent to said gear housing, said working end being configured to have a reciprocating tool blade attached thereto;

a support structure (66; Figs. 3, 4; Pg 3/7-12, 7/1-15) secured to said gear housing configured to support a rotatable scroll collar; and

a generally cylindrical scroll collar (44; Figs. 1-4; Pg 3/1-16, 5/13-7/14) mounted for rotation on said support structure, such that said scroll collar is rotatable relative to said support structure and an attached tool blade (20; Figs 1, 2; Pg 4/5-12).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether the §102(b) rejection of claims 1 and 3 as being anticipated by the Pioch patent should be reversed because Pioch fails to show all of the elements of these claims.

2. Whether the §103(a) rejection of claims 1-3, 19 and 20 should be reversed as being an improper rejection based upon dozens of unidentified patents, and/or Pioch, Ginter and Biek, apparently applied as shown and/or as “modified by the likes of Bourke” and/or many other unidentified patents that show “the well known feature for drills to become reciprocating saws”.

ARGUMENT

1. Claims 1 and 3 are Improperly Rejected Under 35 U.S.C 102(B) as Being Anticipated by Pioch Because Pioch Fails to Show all of the Elements of These Claims.

An invention is anticipated if the same device, including *all* the claim limitations, is shown in a single prior art reference. Every element of the claimed

invention must be literally present, arranged as in the claims in question. *Scripps Clinic and Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). The *identical* invention must be shown by the prior art reference in as much detail as is contained in the patent claim. *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1267 (Fed. Cir. 1991); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780 (Fed. Cir. 1985).

Pioch fails to anticipate, teach or suggest the scroll collar and reciprocating tool assembly as set forth in amended claim 1 because it fails to meet all of the elements of this claim as is necessary for a valid anticipation rejection. Pioch discloses an auxiliary handle for a power tool, and particularly illustrates a hammer drill tool that has a drill bit assembly 22 as described at column 2, line 56, and at column 4, lines 34-36. Pioch describes an auxiliary handle for such a tool which is capable of being attached to a barrel portion 20 of a housing. It has clamping jaws 36 and 38 provided with arcuate shaped concave clamping surfaces 62 and 64, respectively, which cooperate to define a generally annular concave recess when clamping jaws 36 and 38 are pivoted into the closed position shown in Fig. 2. (column 3, lines 45-53)

The auxiliary handle is intended to be attached to the tool and clamped in place and not be rotating during use. This is particularly stated in column 3, line 64-column 4, line 4: "Thus, to utilize the auxiliary handle 30 of the present invention, the

operator simply orients the handle 30 in the desired position with the clamping means 34 and collar portion 66 in an uncompressed condition. The auxiliary handle 30 is thereafter clamped to the barrel portion 20 of the tool by rotating gripping member 32 which compresses clamping jaws 36 and 38 together to thereby compress collar portion 66 causing it to grip barrel portion 20.”

While the specification goes on to indicate that it can be placed in different orientations, it is clear that it is not intended to provide a rotating grip as is set forth in the preamble of claim 1, nor does it meet the last element of the claim which reads, “a generally cylindrical scroll collar carried by said support structure and configured to rotate relative to said support structure and an attached reciprocating tool blade around a scroll collar axis.” The present invention as claimed in claim 1 is for a reciprocating tool that has a *blade*, not a drill bit. It is also submitted that there is a significant difference between the structure of Pioch which is adjustable relative to the tool as contrasted with a rotatable scroll collar that provides a rotating grip as is claimed in claim 1.

The purpose of the rotating grip is to enable an operator to grip the scroll collar with his left hand and manipulate the tool to rotate it around the scroll collar axis to easily rotate the blade without having to reposition his hand on the gripping collar because the scroll collar is configured to rotate relative to said support structure. That is not the structure or operation of Pioch.

Another reason that the Pioch auxiliary handle does not meet the language of the claim is that its handle 32 is what is gripped by a user with the handle 32 being

twisted to tighten the clamping jaws 36 and 38 around the barrel portion 20, and the handle does not satisfy the cylindrical scroll collar element as claimed because it does not rotate around a scroll collar axis.

If the support structure of Pioch is considered to be the clamping jaws 36 and 38, then Pioch has no generally cylindrical scroll collar carried by said support structure, nor does it have a cylindrical scroll collar that rotates *relative* to said support structure--the jaws and handle all rotate *together*.

Alternatively, if the support structure is interpreted to be the barrel portion 20 of the housing 12, then the *entirety* of the auxiliary handle, including the jaws 36 and 38 as well as the stud member 42 and handle 32 (i.e., everything shown in Fig. 2) cannot legitimately be considered to meet the language of a generally cylindrical scroll collar carried by said support structure.

2. Claims 1-3, 19 and 20 Should be Reversed as Being an Improper Rejection Based Upon Dozens of Unidentified Patents, and/or Pioch, Ginter and Biek, Apparently Applied as Shown and/or as “Modified by the Likes of Bourke” and/or Many Other Unidentified Patents That Show “the Well Known Feature for Drills to Become Reciprocating Saws.”

The examiner rejected claims 1-3, 13, 14, 19 and 20 under 35 U.S.C. 103(a) with the following comments providing the basis for this rejection.

It is well known for drills to have generally cylindrical collars rotatable around their gear housings. For example, see the patents to Pioch ‘675, Ginter ‘659 and Biek ‘282 and there are dozens of other occurrences of this in the patent database. It is also well known for drills to become reciprocating saws. For example, see the patent to Bourke ‘293 and there are many other patents that show this feature. It would have been obvious to one of ordinary skill in the art to have modified the likes of Pioch or Ginter, or Biek by providing the reciprocating saw conversion of the likes of Bourke, in order to be able to saw things without having to carry around a separate reciprocating saw.

This rejection is improper for several reasons. The relevance of the very first sentence, i.e., “it is well known for drills to have generally cylindrical collars rotatable around their gear housings” is either misplaced or not understood. Claims 1 and 19 are directed to “a scroll collar and a reciprocating tool assembly” and “a reciprocating tool”, respectively, which have nothing to do with drills. Moreover, the rejection does not put forth a *prima facie* case of obviousness as is required and set forth in decisions of the Court of Appeals for the Federal Circuit.

In the case of *In re Rouffet*, 149 F.3d 1350 (Fed.Cir 1998). the Court stated at 1355:

To reject claims in an application under section 103, an examiner must show an unrebutted *prima facie* case of obviousness. *See In re Deuel*, 51 F.3d 1552, 1557, 34 U.S.P.Q.2d 1210, 1214 (Fed.Cir. 1995). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed.Cir.1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness. *See id.*

While this Court reviews the Board's determination in light of the entire record, an applicant may specifically challenge an obviousness rejection by showing that the Board reached an incorrect conclusion of obviousness or that the Board based its obviousness determination on incorrect factual predicates. This court reviews the ultimate determination of obviousness as a question of law. *See In re Lueders*, 111 F.3d 1569, 1571, 42 U.S.P.Q.2d 1481, 1482 (Fed.Cir.1997). The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed

invention, and the level of ordinary skill in the art. *See Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881, 45 U.S.P.Q.2d 1977, 1981 (Fed.Cir.1998). This Court reviews the Board's factual findings for clear error. *See In re Zurko*, 142 F.3d, 1447, 1449, 46 U.S.P.Q.2d 1691, 1693 (Fed.Cir.1998) (in banc); *Lueders*, 111 F.3d at 1571-72. “ ‘A finding is clearly erroneous when, although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed.’ ” *In re Graves*, 69 F.3d 1147, 1151, 36 U.S.P.Q.2d 1697, 1700 (Fed.Cir.1995) (quoting *United States v. United States Gypsum Co.*, 333 U.S. 364, 395, 68 S.Ct. 525, 92 L.Ed. 746 (1948)).

Here, the examiner has grouped all of these rejected claims together and has not indicated how each of the claims are taught or suggested by specific prior art. It is not known how the prior art that is set forth in the examiner’s comment is applied, if it is applied at all. It is impossible to rebut the rejection, because the examiner fails to specifically apply any of the art that is cited, much less the unidentified art. It is also believed to irrelevant to suggest modification of “the likes of Pioch or Ginter or Biek by providing the reciprocating saw conversion of the likes of Bourke” when the present invention has nothing to do with converting drills to reciprocating saws.

Moreover, since it is impossible to know how or what modifications are to be made, it is impossible to rebut such a basis for rejection, nor can an assessment be

made of whether there was proper motivation for whatever modifications the examiner may have contemplated.

Applicant also disputes that it is well known for drills to have cylindrical collars for providing a rotating grip as is set forth in amended claim 1. If the examiner is referring to the rotating bit tightening portion of drills, no rational user would attempt to grip that part of a drill during operation.

CONCLUSION

The dependent claims not specifically addressed necessarily incorporate the features of the claims from which they depend in addition to defining other features and/or functionality and also should be allowed.

For the above reasons, applicant requests the Board to reverse the outstanding rejections. The case should then be permitted to pass to issue.

Respectfully submitted,

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CLAIMS - APPENDIX

1. A scroll collar and a reciprocating tool assembly for providing a rotating grip, comprising:

a reciprocating tool having a housing and a working end to which a reciprocating tool blade can be attached;

a support structure on said housing adjacent said working end; and

a generally cylindrical scroll collar carried by said support structure and configured to rotate relative to said support structure and an attached reciprocating tool blade around a scroll collar axis.

2. The assembly of claim 1 wherein the reciprocating tool is a saw.

3. The assembly of claim 1 wherein said support structure is a structure attached to said housing having a generally circular interface.

5. The assembly of claim 1 further including a resistance structure disposed between said support structure and said scroll collar.

6. The assembly of claim 5 wherein said resistance structure is at least one O-ring.

19. A reciprocating tool for use with a scroll collar assembly having a support structure and a scroll collar, comprising:

a motor housing;

a gear housing disposed adjacent to said motor housing and a working end disposed adjacent to said gear housing, said working end being configured to have a reciprocating tool blade attached thereto;

a support structure secured to said gear housing configured to support a rotatable scroll collar; and

a generally cylindrical scroll collar mounted for rotation on said support structure, such that said scroll collar is rotatable relative to said support structure and an attached tool blade.

20. The reciprocating tool of claim 19 wherein the tool is a reciprocating saw.

EVIDENCE - APPENDIX

None.

RELATED PROCEEDINGS- APPENDIX

None.